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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,360	06/28/2001	Harukazu Fukami	001560-403	2680

7590 11/03/2003

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EXAMINER

RAYMOND, RICHARD L

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,360

Applicant(s)

FUKAMI ET AL.

Examiner

Richard L. Raymond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>14</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                 |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment / Interview***

1. Pursuant to the telephonic interview of June 16, 2003, the method of use claims are held to be elected and prosecuted herein.
2. The response of July 25, 2003 by way of amendments and/or arguments overcomes the Section 112 rejections of record. The obviousness-type double patenting and prior art rejections of record are maintained below.

### ***Specification***

3. It is requested that a status paragraph referring to the present application being a 371 application be added as the first paragraph of the specification.

### ***Obviousness-type Double Patenting***

4. Claims 11-13 and 15-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-21 of U.S. Patent No. 5,814,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present methods of use appear to involve treatment of the same hosts with the same compounds. Differences merely in scope are involved. One group is rejectable over the other.
5. Claims 11-13 and 15-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/763,213. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because overlapping subject matter is involved. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


***Claim Rejections - 35 USC § 102 / 35 USC § 103***

6. Claims 11-13 and 15-18 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over any of the prior art of record (WO 99/41277; .WO 00/10982; JP 10-053579; the Niwata et al. article; Akahoshi et al. '785; Akahoshi et al. '738 ; Fukami et al. '335 ; EP 795,548 ; Fukami et al. '631 and Tani et al.) for the reasons of record. While the present claims are drawn to methods of use, the rejections of record note that the references all recite various methods of treating cardiac conditions. The present mechanism or mode of action may not be recited, but it is noted that the same hosts are being treated with the same compounds to treat the same cardiac conditions. Where not anticipate, use of structurally obvious variants would be within the skill of the worker in the art.

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ny inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 305-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
Richard L. Raymond  
Primary Examiner